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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/881,736	06/18/2001	Michael Glotzer	0652.2260001/EKS/AES	8755		
26111	7590 06/15/2004		EXAM	EXAMINER		
,	ESSLER, GOLDSTE ORK AVENUE, N.W.	LI, RUI	LI, RUIXIANG			
	ON, DC 20005		ART UNIT	PAPER NUMBER		
	,		1646			

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	· · · · · · · · · · · · · · · · · · ·	A	pplication No.	Applicant(s)				
			09/881,736	GLOTZER ET AL.				
	Office Action Summary	E	xaminer	Art Unit				
		R	uixiang Li	1646				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
A SH THE - Exte after - If the - If NO - Failu Any	ORTENED STATUTORY PERIOD F MAILING DATE OF THIS COMMUN nsions of time may be available under the provisions SIX (6) MONTHS from the mailing date of this comr period for reply specified above is less than thirty (3 period for reply is specified above, the maximum st tire to reply within the set or extended period for reply reply received by the Office later than three months ed patent term adjustment. See 37 CFR 1.704(b).	ICATION. s of 37 CFR 1.136(a munication. 30) days, a reply wit latutory period will a will, by statute, car	In no event, however, may a reply hin the statutory minimum of thirty (3 pply and will expire SIX (6) MONTHS use the application to become ABAN)	be timely filed 0) days will be considered timely 6 from the mailing date of this co				
Status								
1)	Responsive to communication(s) file	ed on <i>09 Mar</i> d	ch 2004.					
,	•		tion is non-final.					
3)□	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims								
4)⊠ 5)□	Claim(s) 1-6 and 11-44 is/are pendid 4a) Of the above claim(s) 1-6,11,12 Claim(s) is/are allowed. Claim(s) 13-33 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restrice	<u>and 34-44</u> is/a	are withdrawn from consid	eration.				
Applicati	ion Papers		•					
 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. 								
Priority u	ınder 35 U.S.C. § 119							
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 								
Attachmen 1) Notice	t(s) e of References Cited (PTO-892)		4) 🔲 Interview Sum	mary (PTO-413)				
2) Notice	e of Draftsperson's Patent Drawing Review (F nation Disclosure Statement(s) (PTO-1449 or r No(s)/Mail Date 1/18/2002.		Paper No(s)/M	ail Date mal Patent Application (PTO	-152)			

DETAILED ACTION

I. Status of Application, Amendments, and/or Claims

The amendment filed on March 9, 2004 has been entered in full. Claims 7-10 have been canceled. Claims 13-44 have been added. Claims 1-6 and 11-44 are pending. Claims 13-33 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

II. Withdrawn Objections and/or Rejections

Applicants' cancellation of claims 7-10 has made all the rejections and objections set forth in the previous office action (Paper No. 13, September 9, 2003) moot.

III. Information Disclosure Statement

The information disclosure statement that was originally filed on January 18, 2002 has been considered by the Examiner and a signed copy of the substitute form PTO-1449 is attached to the office action.

IV. Claim Rejections Under 35 U. S. C. § 112, 1st Paragraph

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one

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skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 26 is drawn to a method for identifying a compound capable of modulating cytokinesis comprising determining said compound's ability to interfere with the ability of a CYK-4 GTPase activating (GAP) or fragment thereof to interact with a member of the MKLP1 subfamily of kinesin-like protein. Clearly, the sequence of the MKLP1 is essential to practice the claimed invention. Without the sequence information, one cannot practice the claimed invention. The sequence cannot be incorporated by references other than to issued U. S. patents or U.S. patent applications to be issued. See, MPEP §608.01(p)(page 600-79). In the instant case, the sequences of the MLKP1 family members are referred to GenBank database (5th paragraph of page 30).

It is noted that Applicant is also required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). The attempt to incorporate subject matter into this application by reference to a commercial sequence database is improper because such a database is subject to change and correction. It is imperative that the sequence as it was known at the time of filing is disclosed in the specification.

New claims 13-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) New claims 13-33 are indefinite because the steps of the methods do not necessarily achieve the goal set forth in the claim preamble. It is unclear how a candidate modulator is selected, determined, and correlated to the preamble.

Applicants argue that new claims 14 and 24 recite steps for the methods recited in new claims 13 and 23. Moreover, each of new claims 14 and 24 recite language that correlates the recited steps in the claim to the preamble of the claim.

This has been fully considered, but is not deemed to be persuasive because the steps of method recited in claim 14 and 24 still do not correlate to the preamble of the claim: identifying a compound capable of modulating cytokinesis. It is unclear from the specification that there is a direct link between "modulating cytokinesis" and "modulating the ability of a CYK-4 GAP to promote GTP hydrolysis by a Rho family GTPase". Furthermore, the essential steps in claims 13 and 23 are missing. It is noted that each method should have necessary steps linking to the preamble of the claim.

(ii) New claims 13-15, 20-27, 31-33 are indefinite because they recite acronyms "CYK-4" and "MKLP1". Applicants argue that new claims 13 and 23 each recites language supported by the specification, that, in addition to the acronyms identifying CYK-4 and/or MKLP1, describes each of the proteins. Applicants further submit that new claims 23 recites "a member of the MKLP1 subfamily of kinesin-like proteins" and,

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in new claims that explicitly recite human CYK-4, the identifying phrase "SEQ ID NO: 2"

is recited as well.

This has been fully considered, but is not deemed to be persuasive because the

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change of the language recited in the claims does not change the fact that the

acronyms are still used in the claims and recitation of SEQ ID NO: 2, for example, in

claims 16 and 17, does not define and limit the scope of invention in other claims that

do not recite a sequence identifier.

(iii) New claims 23-33 are indefinite because each claim recites the term

"interact" or "interaction". Applicants argue that the term "interaction" is used throughout

the specification to indicate binding and/or association in a complex. This is not

persuasive because there is no unambiguous definition of the term "interaction" such

that one skilled in the art would know the metes and bounds of the term. If the term

"interact" is intended to mean "binding", the claims should be amended so.

(iv) New claim 13 23, and 25 are indefinite because claim 13 recites "a GAP

domain" in line 4, whereas claims 23 and 25 recite "a domain of said CYK-4 GTPase

activating protein". Since neither the art nor the specification defines the terms

unambiguously, the claims are indefinite.

(v) New claim 30 is indefinite because it recites "the N-terminal region containing

amino acids 1-120". It is unclear what is referred by the term.

VI. Claim Objections

Claims 13-16, 18, 20-26, 28, and 30-33 are objected to because they recite nonelected subject matter.

Applicants argue that new claims 13-33 recite only elected subject matter. The generic claims are permitted in an application during prosecution, after an election of species had been made. This is not found to be persuasive. While claims that recite more than one elected species are permitted in an application during prosecution, those claims will remain objected to during prosecution. The Examiner clarifies that the restriction to a single CYK-4 polypeptide in Paper No. 1o (April 17, 2003) is not a species election; rather it sets forth additional invention groups. In the instant case, Applicants elected human CYK-4 polypeptide.

VII. Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of Application/Control Number: 09/881,736

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the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875.

The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00

pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gary Kunz, can be reached on (571) 272-0887.

Communications via Internet e-mail regarding this application, other than those

under 35 U.S.C. 132 or which otherwise require a signature, may be used by the

applicant and should be addressed to [Gary.Kunz@uspto.gov]. All Internet e-mail

communications will be made of record in the application file. PTO employees do not

engage in Internet communications where there exists a possibility that sensitive

information could be identified or exchanged unless the record includes a properly

signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is

more clearly set forth in the Interim Internet Usage Policy published in the Official

Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-1600.

Ruixiang Li Examiner June 2, 2004

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